

# Office Action Summary

Application No.

09/422,025

Applicant(s)

SONG, SANG G.

Examiner

Terressa M. Boykin

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-14 is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16. 6) ☐ Other: \_\_\_\_\_



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,025	10/20/1999	SANG G. SONG	1580.03	4968

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EXAMINER

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ART UNIT

PAPER NUMBER

1711

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by USP 5952429 note abstract, col. 12 line 20 through col. 22 line 56, and excerpts or selections below.

US 5952429 discloses a photo-curable resin composition which can form a black film when it is applied to a varying substrate such as, for example, glass plate, plastic sheet or film, paper, synthetic paper, or silicon wafer by a varying coating means such as, for example, a bar coater, a spin coater, a roll coater, a spray coater, dipping, gravure printing, or screen printing. This invention further concerns a liquid ink jet printing medium and a liquid developing agent for electrostatic development, each containing the above mentioned any carbon black graft polymer of this invention as a coloring agent compo

A product obtained by adding the carbon black graft polymer of this invention to such a binder as is used for a coating composition is capable of forming a strong film when it is applied to a varying substrate. As concrete examples of the binder effectively usable

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herein, thermoplastic resins, thermosetting resins, and reactive resins may be cited. One member or a mixture of two or more members may be selected from among these resins depending on the kind of use. The other uses found for the carbon black graft polymer according to this invention, though not particularly limited, include various resinous compositions, coating compositions, inks, thermographic transfer inks, thermographic transfer ink ribbon coating agents, backcoating agents for magnetic recording media, etc

As the liquid recording medium to be used in the ink jet printing method, the product composed principally of a dye as a coloring agent component and a solvent therefor has been mainly used heretofore.

As concrete examples of the inorganic pigment, powders or particles of alumina, titanium dioxide, barium titanate, magnesium titanate, calcium titanate, strontium titanate, zinc oxide, silica sand, clay, mica, tabular spar, diatomaceous earth, various kinds of inorganic oxide pigments, chromium oxide, cerium oxide, iron oxide red, antimony trioxide, magnesium oxide, zirconium oxide, barium sulfate, barium carbonate, calcium carbonate, fine silica powder, silicon carbide, silicon nitride, boron carbide, tungsten carbide, titanium carbide, and cerium oxide may be cited other than such species of carbon black as cited above.

The liquid dispersion medium to be used in the method of surface treatment of this invention for holding the minute solid particles and the reactive polymer therein is not particularly limited. It may be any of various water-soluble and water-insoluble liquid dispersion media. esters such as ethyl benzoate, octyl benzoate, dioctyl phthalate, etc.

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Note that applicants' claim 1 is broadly disclosed as a printable paper, having a coating of silicon and further treated with an acrylic polymer binder which as mentioned above may be ethyl methacrylate which is a well known binder and dioctyl phthalate in the dispersion medium which is also a well known plastizicer .

With regard to applicants' claim 2 wherein a the mixture has a "slippery texture" would appear to be inherent in the moieties employed.

In view of the above, there appears to be no significant difference between the reference and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

**Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Terressa Boykin, via the receptionist whose telephone number is (703) 308-2351. The examiner can normally be reached on Monday through Friday from 8:00a.m.-5:30 p.m.

tmb



Examiner Terressa Boykin  
Primary Examiner  
Art Unit 1711